REMARKS

The Office Action dated November 9, 2007 has been received and carefully considered. Claims 1-13 and 15-21 are pending. Claim 14 is canceled without prejudice or disclaimer to the subject matter set forth therein. Claims 1, 15, 17, 20 and 21 are amended. No new matter has been added.

Reconsideration of the outstanding rejections in the present application is respectfully requested based at least on the following remarks.

A. The Objections to claims 1, 3, 4, 17, 18 and 21

In the Office Action, claims 1, 3, 4, 17, 18 and 21 are objected to because of the use of the term "the space." The Office Action finds that this term has no antecedent basis. The above mentioned claims are amended to provide antecedent basis.

B. The Rejections under 35 U.S.C. §112

In the Office Action, claims 1, 10, 13, 17, 20 and 21 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is traversed.

Under MPEP 2173.05(b), when a term of degree is presented in a claim, first a determination is to be made as to whether the specification provides some standard for measuring that degree. If it does not, a determination is made as to whether one of ordinary skill in the art, in view of the prior art and the status of the art, would be nevertheless reasonably apprised of the scope of the invention. Even if the specification uses the same term of degree as in the claim, a rejection may be proper if the scope of the term is not understood when read in light of the specification. While, as a general proposition, broadening modifiers are **standard tools** in claim drafting in order to avoid reliance on the doctrine of equivalents in infringement

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actions, when the scope of the claim is unclear a rejection under 35 U.S.C. 112, second paragraph, is proper. See *In re Wiggins*, 488 F. 2d 538, 541, 179 USPQ 421, 423 (CCPA 1973).

MPEP 2173.05(b), further sets forth, the term "substantially" is often used in conjunction with another term to describe a particular characteristic of the claimed invention. It is a broad term. *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). The court held that the limitation "to substantially increase the efficiency of the compound as a copper extractant" was definite in view of the general guidelines contained in the specification. *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The court held that the limitation "which produces substantially equal E and H plane illumination patterns" was definite because one of ordinary skill in the art would know what was meant by "substantially equal." *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988).

Applicant submits that the one of ordinary skill in the art, in light of the present specification and teachings therein, would indeed know what was meant by the term "substantially", as such term is used in the claims. The Office Action has provided no showing as to why the one of ordinary skill would not know such meaning.

Withdrawal of the 35 U.S.C. §112 rejections is requested.

C. The Rejections under 35 U.S.C. § 103(a)

In the Office Action, claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chakraborty in view of Zosin (US Patent Application Pub. No US 2004/0181479A1). Applicant respectfully submits that the Chakraborty reference does not qualify as prior art for the purpose of the §103(a) rejections stated in the Office Action. Under §103(c)(1),

> "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude

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> patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person."

Applicant respectfully submits that the subject matter and the claimed invention were both owned, or subject to an obligation of assignment, to the same entity at the time the claimed invention was made. Applicant also notes the existence of at least one common inventor between the Chakraborty reference and Applicant's application.

Applicant submits with this response a copy of the assignment records for both of the applications. The records show that the inventors in the present application (10/781,898) assigned the application to the General Electric Company. The inventors in the Chakraborty application (10/390,689) assigned the application to GE Financial Assurance Holdings, Inc. General Electric Company is the parent company for GE Financial Assurance Holdings, Inc., and therefore the applied art and the invention claimed in the current application were commonly owned at the time the claimed invention was made. In support of such relationship, attached hereto is a GE Financial Assurance Holdings, Inc. Form 10-K SEC Filing - for the fiscal year ended 12/31/2002 (Pages 1-4). If the Examiner deems it necessary, Applicant will submit an affidavit under 37 CFR 1.131, or other documentation, to further substantiate this submission of common ownership.

Applicant further submits that the Chakraborty reference is not available as prior art under 35 U.S.C. §102 subsections (a), (b), (c) or (d). Applicant submits that the Chakraborty reference represents a "printed publication" as understood for the purposes of §102(a) and has a filing date of March 19, 2003 and a publication date of September 23, 2004. Applicant further submits that the current application has a filing date of February 20, 2004. The effective filing date of the current application is approximately seven months earlier than the publication date of

the Chakraborty reference. Thus, the Chakraborty reference does not qualify as prior art under §102 (a) or (b). The Chakraborty's lack of qualification as prior art under §102 (c) or (d) is immediately apparent.

In conclusion, Applicant submits that U.S. Patent Application 10/390,689 (2004/0186804) is unavailable as prior art as a basis for a rejection under 35 U.S.C. §103. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. 103(a) rejection.

D. The Rejections under 35 U.S.C. §102(e)

In the Office Action, claims 1-13 and 16-21 are rejected under 35 U.S.C. §102(e). Applicant submits that the rejection of the above claims under §102(e) is moot in view of the amendments set forth in this response.

The Office Action indicated that the above rejections may be overcome by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. The Applicant neither acknowledges nor denies that the teachings disclosed in Chakraborty and applied in the rejections under §102(e) was derived from the inventor(s) of this application (10/781,898). Rather, the claims have been amended to expedite the prosecution of this application and to render moot the 35 U.S.C. 102(e) rejection in the prosecution of this present application.

Applicant respectfully requests withdrawal of the 35 U.S.C. 102(e) rejection.

E. Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed

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telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for extensions of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

HUNTON & WILLIAMS LLP

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AD/PTO2.11.2008

Attachments:

- GE Financial Assurance Holdings, Inc. Form 10-K SEC Filing - for the fiscal year ended 12/31/2002 (Pages 1-4)
- Patent Assignment Abstract of Title for US Application No. 10/390,689 (1 page)
- Patent Assignment Abstract of Title for US Application No. 10/781,898 (1 page)